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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/896,838	Applicant(s) MARCUS, DWIGHT
	Examiner MICHAEL BEKERMAN	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 05 April 2010.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 149-165 is/are pending in the application.
 4a) Of the above claim(s) 158-162 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,149 and 163-165 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08c)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

This action is responsive to papers filed on 4/5/2010.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 1, 149-157, and 163-165 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, this claim recites the limitations "receiving at a computer", ":determining by the computer", and "providing by the computer". However, the specification indicates approximately 145 iterations of the language "in one embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding the computer) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is

the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 1, this claim recites the limitation “a plurality of orthographic appearances of words apart from the meaning of the words”. Nowhere in the specification is the “meaning” or “topic” of words discussed. Applicant claims to have removed the term “signifier” and replaced the term with the definition. The Merriam Webster definition of “signifier” is “a symbol, sound, or image (as a word) that represents an underlying concept or meaning”. This is contrary to what the Applicant has amended, and further shows that Applicant has no support for such a limitation. Since the common interpretation of signifier is that it represents an underlying concept or meaning, and since Applicant has never specified otherwise in the specification, to state otherwise is considered new matter. Nothing about an “orthographic appearance” is ever mentioned in the specification, nor is the meaning of words ever referenced. Claims 149 and 150 inherit this rejection through dependency from claim 1.

Regarding claim 1, this claim recites the limitation “providing the incentive...only if the indication has been determined to demonstrate the sufficient knowledge”. This limitation is meant to exclude an incentive of any kind as being offered unless sufficient knowledge is indicated, and applicant's specification has no support for such an exclusion. Rather, the specification is directed primarily towards giving an incentive should a user display sufficient knowledge, but never specifies that the incentive is specifically not obtainable should sufficient knowledge not be displayed. Any negative

limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. See MPEP 2173.05(i).

Claims 149 and 150 inherit this rejection through dependency from claim 1.

Regarding claim 149, this claim recites the limitation “said signifier use instruction comprises a conversion code”. However, the specification indicates approximately 145 iterations of the language “in one embodiment” or “in another embodiment”. These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding the conversion code) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter. Claim 150 inherits this rejection through dependency from claim 149.

Regarding claim 150, this claim recites the limitation “said another type of information comprises contact information for claiming the incentive”. However, the specification indicates approximately 145 iterations of the language “in one embodiment” or “in another embodiment”. These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding contact information to claim an incentive) was never disclosed as being usable with the information from the parent independent claim

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(which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 151, this claim recites the limitation "the instructions pertain to extracting information independent of a meaning of the text form information in which the text form signifiers are inserted". Nowhere in the specification is the "meaning" or "topic" of words or information discussed. Since Applicant has never addressed the meaning or topic of information or how it pertains to such instructions in the specification, this is considered new matter. Claims 152-157 and 163-165 inherit this rejection through dependency from claim 151.

Regarding claim 151, this claim recites the limitations "receiving by a computer" and "verifying by the computer". However, the specification indicates approximately 145 iterations of the language "in one embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding the computer) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to

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claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 153, this claim recites the limitation "wherein the text form information comprises instructional material...making available support associated with a product or service....customer support is made available...in a second manner". However, the specification indicates approximately 145 iterations of the language "in one embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding instructional material and customer support) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter. Claims 154 and 155 inherit this rejection through dependency from claim 153.

Regarding claim 154, this claim recites the limitation "the first manner is a lower cost than the second manner". However, the specification indicates approximately 145 iterations of the language "in one embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding a lower cost second manner) was never disclosed as being usable with the information from the parent

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independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 155, this claim recites the limitation "disclosing a toll-free customer support number". However, the specification indicates approximately 145 iterations of the language "in one embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding a toll-free customer support number) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 156, this claim recites the limitation "the text form information comprises medical instructions and access to medication is provided". However, the specification indicates approximately 145 iterations of the language "in one embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding medical instructions or access to medicine) was never

disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 163, this claim recites the limitation "the text form information comprises an instruction manual". However, the specification indicates approximately 145 iterations of the language "in one embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding an instruction manual) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 164, this claim recites the limitation "providing an article...having a substrate having multiple layers having printed information thereon, the signifiers enabling the information consumer to engage in the removal, application, and/or repositioning of elements on the article, to reveal information". However, the specification indicates approximately 145 iterations of the language "in one

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embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding repositioning of elements) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter. Claim 165 inherits this rejection through dependency from claim 164.

Regarding claim 165, this claim recites the limitation "the text form information comprises instructional material relating to a product or service, and the revealed information is a toll-free customer support telephone number". However, the specification indicates approximately 145 iterations of the language "in one embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding instructional material and a toll-free number) was never disclosed as being usable with the information from claim 164 (regarding repositioning of elements) or the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 3

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embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 148-150 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGregor (U.S. Patent No. 5,236,200) in view of Sporgis (U.S. Patent No. 6,320,495).

Regarding claim 1, McGregor teaches providing information to an information consumer (treasure hunt game card) (Figure 1) with a plurality of signifiers enclosed therein (appearance of the words that form clues) (Column 1, Lines 59-63). A signifier use instruction is inherent when the treasure hunt game is provided (follow the clues to get to the treasure). Should the information consumer display sufficient knowledge of the appearance of the words, to decipher the clues, they will receive an incentive (the treasure/gift) (Column 1, Lines 59-63). The claim language is very broad and does not specify who performs the steps of the method. Therefore, the step of receiving could be performed by an onlooker or the consumer himself (both of which would be inherent). A step of determining could also be done by an onlooker or the consumer himself (if the consumer finds the prize, this proves to the consumer or an onlooker that the consumer

knows how to read the clues). The consumer is provided with the incentive only if sufficient knowledge of the appearance of the signifiers is demonstrated. Otherwise, the prize remains unfound.

McGregor does not appear to specify a computer as performing the receiving, determining, and providing steps. Sporgis, however, discloses a treasure hunt game in combination with a GPS and gamemaster computer program (Column 2 Line 61 – Column 3 Line 18) in which the gamemaster receives indications from the consumer (location information), determines if the user is displaying sufficient knowledge of clues by determining if the location is correct, and providing an indication to provide an incentive (more clues, or the final prize) (Column 3 Lines 28-36, Column 3 Line 56 - Column 4 Line 7, and Column 5, Lines 4-43). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a computer and GPS system in playing a game of treasure hunt as computers automate processes to make them easier.

Regarding claims 149 and 150, McGregor teaches anagrams and puzzles as clues (Column 3, Lines 14-22). This represents a conversion code for conversion of the clue to another type of information that may be used to locate and claim the incentive (contact information).

3. **Claims 151-155 and 163-165 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sony (Owner's Manual, Sony Video Cassette Recorder Model SLV-662HF, 1999) in view of Muller (U.S. Patent No. 5,561,711).**

Regarding claims 151-155, 163, and 165, Sony teaches providing text form information (the manual itself) having text form signifiers enclosed within (the toll-free phone number at the bottom of the last page). If the consumer reviews the Sony manual and finds the phone number, then the customer is rewarded with toll-free customer service. However, if the customer does not sufficiently review the manual to find the toll-free phone number, they will inherently need to seek other options for customer service, such as driving to a retail establishment (which would inherently cost more than a toll-free number would). The numbers in the phone number are each in a different separate location than the other numbers (in 80, the 8 is beside the 0, and this reads on plural separate locations and being located "throughout" the manual). The signifier numbers are the same font as all the information around it, so they are typeset consistently with the text form information. There are signifier instructions included as well ("If you have any questions about this product, you may call", bottom of last page). The meaning of the text form information in which the signifiers are inserted is "operation of a VCR". The signifier instructions do not teach one how to use a VCR, and therefore the instructions are independent of the meaning of the text form information.

Sony does not appear to specify a computer as performing the receiving and verifying steps. Muller, however, teaches a automated computer system that automatically answers incoming calls and routes the calls to available agents (Abstract). Therefore, the computer system of Muller would receive the phone call from the consumer (indication) thereby verifying that sufficient knowledge of the phone number

dialed was demonstrated. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an automated answering service because Muller teaches that such automated features bring increased efficiency to businesses (Column 2 Lines 14-16).

Regarding claim 164, the Sony document in and of itself represents an article on which signifiers were recorded, the article having multiple layers (pages) with information printed thereon, and the consumer is enabled to reposition the pages to reveal information. As the signifiers do not prevent the flipping of pages, this enables the user to flip pages.

4. **Claims 151, 156, and 157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson (U.S. Patent No. 3,926,325) in view of Karpf (U.S. Pub No. 2005/0165626).**

Regarding claims 151, 156, and 157, Benson teaches providing information on the side of bottles (provided text form information) including instructions about how to open the child-proof cap (text form signifiers) (Figure 3, Column 1, Lines 26-37). The bottle of Benson is meant for medicine (Column 2, Lines 39-41), and thus the text form provided information are medical instructions. Should the consumer display sufficient knowledge of the signifiers, they may use the signifiers (instructions) to gain access to the medication within the bottle. The claim language is very broad and does not specify who performs the steps of the method. Therefore, the step of receiving could be performed by an onlooker or the consumer himself (both of which would be inherent). A

step of verifying could also be done by an onlooker or the consumer himself (if the consumer is taking the medicine, this proves to the consumer or an onlooker that the consumer knows how to open the bottle). Each letter of the directions on the bottle of Benson are in a different separate location than the other letters (in "discard", the "d" is beside the "l", and this reads on plural separate locations). The signifier letters are the same font as all the information around it, so they are typeset consistently with the text form information. There are signifier instructions included as well ("For general use" or "For child-protective use", Figure 3). The meaning of the text form information in which the signifiers are inserted is "identification of the device on the upper portion of the bottle" (Figure 3, see "Reversible – Stopper/Cap"). The signifier instructions have a different meaning than mere identification of the device on the upper portion of the bottle, and therefore the instructions are independent of the meaning of the text form information.

Benson does not appear to specify a computer as performing the receiving and verifying steps. Karpf, however, discloses sending a user medical information through a computer system, receiving an indication from the user through the computer system, and verifying by the computer system that the user has demonstrated sufficient knowledge of the information (Paragraphs 0012-0020). It would have been obvious to one having ordinary skill in the art at the time the invention was made to supply and monitor medical instructions intended for users using a computer system so that doctors can be sure that patients understand the medical instructions presented to them.

Response to Arguments

5. Examiner has added new 112 1st new matter rejections above that require immediate attention alongside the other 112 1st new matter rejections.
6. **Applicant argues** “the term signifier has been removed from claim 1 and the definition of signifier...has been employed directly”. The Merriam Webster definition of “signifier” is “a symbol, sound, or image (as a word) that represents an underlying concept or meaning”. Although Applicant has claimed to add the definition of signifier into the claim, Examiner can’t find this definition anywhere. In fact, the amendments to the claim actually contradict the Merriam Webster definition of signifier. Therefore, this rejection has been altered to reflect the amended claim language, but is still maintained as Applicant has absolutely no support for such a limitation.
7. **Applicant argues** “one of ordinary skill in the art would clearly understand upon reading the specification that the incentive is provided only if sufficient knowledge is demonstrated. Otherwise, there is simply no reason to provide the incentive”. On the contrary, a consolation prize is generally awarded for simply making an attempt to accomplish something, whether that attempt was successful or not. As explained in the rejection, the word “only” means that a prize is explicitly not given should sufficient knowledge not be demonstrated, and Applicant’s specification never addresses such a scenario, and therefore lacks support for this negative limitation new matter.
8. **Applicant argues** “One of ordinary skill in the art would clearly understand which variations or embodiments are usable together. For example, one of ordinarily skill in the art reviewing the specification would understand that the various modes of

communication set forth on page 23, lines 6-12, i.e., electronic mail, a telephone call, connection to a website, postal mailing, faxing or otherwise transmitting a written response, are not entirely separate from all other disclosure in the specification, as the Examiner apparently contends." The Examiner, however, is skilled in the art and has absolutely no idea how the information contained within the "Event Focused Information" section of the specification (Pages 30-31) for example may be used in combination with such operations as electronic mail, connection to a website, faxing, etc. As further example of how all of the embodiments appear to be separate, the medicine bottle embodiment (Page 26, Lines 1-5) seems to have absolutely nothing to do with the event focused information embodiment (Pages 30-31). In fact, the medicine bottle embodiment never even states how a computer would be used to verify anything, as it appears that a code may unlock the container without a computer ever being involved. The entire specification appears to merely be a mish-mash of ideas thrown together, and Examiner has difficulty finding a single unitary invention anywhere within (if one even exists). Because the embodiments are all separate, claiming of the embodiments together as a single invention would be new to the application, and therefore represents new matter.

9. **Applicant argues** "there is no requirement that the wording of the claims [topic and meaning] be contained in the same terms...in the specification. The extracting of such information is clear, for example, from the instruction to copy down the letter at the end of the word, without reference to the meaning of the sentence, as disclosed...on page 22, Lines 9-13". The section cited by the Applicant says nothing about the

meaning of the sentence and contains nothing about disregarding such a meaning.

Therefore, this argument is moot, and the rejection remains valid.

10. **Applicant argues** “[Examiner’s] position is not a reasonable reading of the wording plural separated locations”. However, since each number does not directly overlap the others, the numbers are indeed in different locations. The claims do not place any requirements on the locations (i.e. distance apart, etc), and therefore such an interpretation is entirely valid.

11. All other arguments are believed to have been addressed by the amended rejections above.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Thursday, 9:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Bekerman/
Primary Examiner, Art Unit 3622